Paper No. 65

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY H. REMISZEWSKI,
DAVID T. GREEN and HENRY BOLANOS

Appeal No. 1999-2065
Application No. 08/651,502

ON BRIEF

Before FRANKFORT, MCQUADE and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4, 7-9, 19, 45 and 46 and from the

examiner's refusal to allow claims 3, 14, 15 and 20 as amended in the after final amendment, Paper No. 53, filed December 18, 1998. Claims 13, 21-23, 26, 28-31, 34-39 and 44 stand allowed, and
claims 10 and 11 are objected to as being dependent on a rejected base claim and according to the examiner would be allowable if rewritten in independent form. Claims 5, 6, 12, 16-18, 24, 25, 27, 32, 33 and 40-43 have been canceled.

BACKGROUND

Appellants' invention relates to a surgical stapling apparatus including a first handle member (30) with a jaw member (33) having a staple-retaining member (90) and a second handle member (10) with a jaw member (14) having an anvil (16). The handle members are pivotally connected to each other (at 50). The apparatus further includes a staple pusher

(70) adapted to advance staples into contact with the anvil to secure tissue, and a trigger (60) being operatively connected with the staple pusher when the jaw members are in the closed position and the trigger being moved from operative connection to an inoperative associa- tion with the staple pusher in response to movement of the jaw

members from the closed to an open position (claim 1). Independ- ent claim 45 recites a surgical stapling apparatus wherein the trigger assembly (60) is slidably connected to the second handle
(10) and has a distal portion (58) engageable with an angled camming portion (86) of actuator lever (80) in the closed position of the anvil and staple magazine to facilitate actuation of the staple pusher and said distal portion of said second handle being disengaged with the angled camming portion in response to movement of said anvil and staple magazine to an open position to prevent actuation of the staple pusher.

The prior art references of record relied upon by the examiner in rejecting claims 1-4, 7-9, 14, 15, 19, 20, 45 and 46 are:

Fischer	960,300	June 7, 1910
Olson	2,853,074	Sept. 23, 1958
Takaro	3,269,631	Aug. 30, 1966

The following rejections are before us for review.[1]

Claim 45 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Fischer.

Claims 1-4, 7-9, 14, 15, 19, 20 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olson in view of Takaro.

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[1] We note that in claim 1, line 10, the recitation of "the tissue" appears to lack antecedent basis. It is further noted that claim 45 contains a similar limitation and provides proper antecedent basis in line 6. During any further prosecution of this application before the examiner, it is suggested that claim 1 be amended, using language similar to that of claim 45, to provide proper antecedent basis for "the tissue" or, in the alternative, to delete "the" before "tissue."

Rather than attempt to reiterate the examiner's full statement with regard to the above-noted rejections and conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the examiner's answer (Paper No. 55, mailed February 1, 1999) and the office actions of Paper Nos. 38 and 47 (mailed January 22, 1996 and December 23, 1997, respectively) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 54, filed December 18, 1998) and reply brief (Paper No. 56, filed March 31, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions as set forth by the appellants and the examiner. As a conse- quence of our review, we have made the determination that neither of the examiner's rejections will be sustained. Our reasoning in support of this determination follows.

With regard to the 35 U.S.C. § 102(b) rejection of claim 45 as being anticipated by Fischer, the examiner asserts that the trigger (rack 14 of Fischer) "is fully capable of being disengaged with angled camming portion (the teeth of wheel 22) when the anvil and magazine are moved to the open position merely by the user moving the trigger to the far right side of the arm (17) while moving the anvil and magazine to the opened position" (answer page 7). Appellants urge that

> Fischer does not disclose or suggest a stapling apparatus having, inter alia, (1) an actuator operatively associated with a pusher and having an angled camming portion formed thereon, and a trigger having proximal and distal portions, wherein the distal portion
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> is engageable with the angled camming portion in the closed position of the anvil and magazine to facilitate actuation of the pusher, and (2) a distal portion of a trigger disengageable with the angled camming portion in response to movement of the anvil and magazine to the open position to prevent actuation of the pusher [brief, page 18].

In the reply brief (page 4), appellants urge that "Fischer's trigger is not disengaged from the actuator in response to

movement of the jaws to the open position and can eject staples in both the open and closed positions."

We do not agree with the examiner's position for the following reasons. Initially, it is noted, that in Fischer the "teeth of wheel 22" do not contact the rack (14) as asserted by the examiner. Instead, the teeth of wheel (22) contact the chain (20) as shown in Figure 1. It appears that the examiner may have actually intended to refer to the teeth on the pinion (15) as contacting the rack (14). Nevertheless, our review of Fischer's wire stitching instrument or surgical stapler reveals that the first and second handles therein, respectively having a staple magazine (a) and anvil (b) associated therewith, and the staple ejecting mechanism including crank (18), sprocket wheels (19)

and (22), chain (20), rack (14) and star-wheels (26), are <u>not</u> structurally associated with one another in the manner required by appellants' claim 45 on appeal. More

specifically, the rack (14), identified by the examiner as corresponding to the "trigger assembly" of appellants' claim 45, does not have a distal portion that is engageable with an angled camming portion of the actuator or staple ejecting mechanism in the closed position of the anvil (b) and staple magazine (a) to facilitate actuation of a staple pusher and wherein the distal portion is "disengaged with the angled camming portion in response to movement of said anvil and said magazine to the open position of the jaws to prevent actuation of the pusher" (emphasis added), as in appellants' claim 45.

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is

served by the recited element, ingredient or step. Clearly, Fischer does not contain structure such that the rack or trigger (14) is disengaged with the angled camming portion "in response to" movement of the jaws to the open position, as recited in
claim 45 on appeal. Instead, the movement of the rack (14) of Fischer is clearly independent of the movement of the jaws and, as urged by appellants, Fischer's rack or trigger (14) is not disengaged from the actuator in response to movement of the jaws to the open position, but is operatively associated with the actuator therein and can apparently eject staples in both the open and closed positions of the jaws.

Contrary to the examiner's assertions in the answer (pages 6-8), we do not see that the examiner has given the language of claim 45 on appeal its broadest "reasonable" interpretation or that the examiner has read the limitations of claim 45 on the structure found in Fischer in a reasonable manner. During patent examination, the pending claims must be

"given the broadest reasonable interpretation consistent with the specification." In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). The

> PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlighten- ment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.
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> In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Moreover, Fischer lacks additional structural elements recited in claim 45 on appeal. Claim 45 recites "a second handle having an anvil at a distal end" (line 4) and "a

trigger assembly having a trigger slidably connected to said second handle" (line 12) (emphasis added). Although the examiner never indicates which element of Fischer is considered to comprise the "anvil," we consider that one of ordinary skill in the art

would have appreciated that the depressions 33 in jaw (b) of Fischer's instrument constitute an anvil. Clearly, the handle of Fischer that includes the "anvil" does not include a slidably connected trigger as claimed. Instead, the trigger (14) of Fischer as identified by the examiner is connected to the handle which corresponds to appellants' claimed "first handle" carrying the staple magazine.

For the reasons noted above, the examiner's rejection of claim 45 under 35 U.S.C. § 102(b) will not be sustained.

With regard to the 35 U.S.C. § 103 rejection of claims 1-4, 7-9, 14, 15, 19, 20 and 46 as being unpatentable over Olson in view of Takaro, appellant asserts that

> [n]either Olson nor Takaro disclose a stapling apparatus having, inter alia, a trigger operatively connected to the staple pusher when the jaw members are in the closed position, and being inoperatively associated with the staple pusher when the jaw members are in the open position, wherein the trigger is moved from operative connection to inoperative association in response to movement of the jaw members from the closed to the open position [brief, page 13].

In this section of the brief, appellants further urge that "Olson's staple trigger 48 is always in operative association with the staple pusher 46 and therefore staples can disadvantageously be fired when the jaws are open" and that "Takaro's catch mechanism 32 including tip 33 can be moved into and out of engagement with pin 38 manually to prevent or permit firing of the staples regardless of whether the jaws are in the open or closed position." The examiner urges that "Takaro discloses a

trigger that is capable of being operatively connected to the staple pusher when the jaw members are in the closed position by the user releasing the latch (13) to allow the pusher to drive staples out of the housing and against the anvil" (answer, page 4), and that "Takaro's trigger is fully capable of being moved from operative connection to inoperative association with the staple pusher in response to movement of the jaw members from the closed to the open position by the user moving the latch (13) simultaneously with the movement of the jaw members from the closed to the open position, as shown in Figures 2 and 4" (answer, page 5).

We agree with appellants position that "[n]either Olson nor Takaro disclose a stapling apparatus having, inter alia, a trigger operatively connected to the staple pusher when the jaw members are in the closed position, and being inoperatively associated with the staple pusher when the jaw members are in the open position, wherein the trigger is moved from operative connection to inoperative association in

response to movement of the jaw members from the closed to the open position" (brief, page 13). Moreover, we do not agree with the examiner's position regarding the Takaro patent. Again, we note that a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used and that a functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. While the trigger (1), as identified by the examiner (answer, page 4), of Takaro may be "capable of being moved from operative connection to inoperative association with the staple pusher" as asserted by the examiner

at page 5 of the answer, the claims specifically require "said trigger being moved from operative connection to inoperative association with the staple pusher in response to movement of

the jaw members from the closed to the open position" (claim 1, lines 14-16, emphasis added). The examiner states that "it remains unclear what structure is being claimed that provides for the trigger to be moved in response to movement of the jaw members from the closed to the open position" (answer, pages 5 and 6). We consider that this functional recitation requires a structural interrelationship between the trigger, the staple pusher and the jaw members such that the device is capable of performing this function. Clearly, Takaro lacks any such structural interrelationship. Thus, the movement of the latch (13) of Takaro to the inoperative position by a user (i.e. as depicted in Figure 2 of Takaro), is not "in response to" movement of the jaw members from the closed to the open position. Instead, the latch (13) of Takaro is clearly moved to the inoperative position by direct action of the user. This movement by the user is independent of the movement of the jaw members. Accordingly, the examiner's rejection of

claim 1 and dependent claims 2-4, 7-9, 14, 15, 19, 20 and 46 under 35 U.S.C. § 103 will not be sustained.

CONCLUSION

To summarize, none of the examiner's rejections is sustained. The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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